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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,195	10/21/1999	DIMITRI KANEVSKY	12837(YO999-	5232

7590 09/19/2002

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/422,195

Applicant(s)

KANEVSKY ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 13-18, 20, 22, 28-31, 33, 35 and 41 is/are rejected.
- 7) ☒ Claim(s) 4, 6, 8-12, 19, 21, 23-27, 32, 34 and 36-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 18 June 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/422,195 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5, 7, 13-18, 20, 22, 28-31, 33, 35 and 41 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Alexander et al.
6. Alexander et al. teaches (independent claims 1, 16 and 29) a system, method, and program storage device readable by a machine, for generating an advertisement optimized for two or more persons, the method comprising: a) obtaining data relating to characteristics of said two or more persons (col. 28 lines 23-32), which reads on data related to detected

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characteristics of said two or more persons (see para. 8 below), while engaged in the common activity of using a television electronic program guide (EPG); b) collecting data related to Internet searches (col. 28 lines 60-62), which reads on data based on said obtained data; c) and d), extracting common elements from the detected characteristics and associating/generating ads for products and services with said common elements (col. 29 line 12 to col. 32 line 21); and e), transmitting said optimized ad to said two or more persons at a television communications device (col. 32 line 22-37).

7. Alexander et al. does not explicitly teach that said two or more persons are engaged in the common activity at a public location. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the invention would apply to a television in a sports club or bar, which is a public location. These public venues inherently have cable television with an EPG.
8. No special weight was given by the examiner to "detected characteristics". Applicant argues (middle of p. 5 of Amendment B filed 28 May 2002) that "detected characteristics ... refers to obtaining image data ... and other characteristic data such as biometrics and GPS data via appropriate sensors." This does not qualify as the "clear definition" required by MPEP § 2111.01: The specification does not establish the metes and bounds of the term "detected characteristics". A "clear definition" must unambiguously establish what is and what is not included. It is helpful if definitions are gathered in a section labeled definitions, or are preceded by phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". In the instant case, the examiner is required to give the term its broadest reasonable interpretation (MPEP § 2111), which the examiner judges to be any characteristic of said two or more persons that is detected by any means. This is supported by p. 8, lines 8-17 of the specification, which broadens applicant's list of means by which said characteristics may be detected.
9. Alexander et al. also teaches at the citations given above dependent claims 2, 5, 7, 13-15, 17, 20, 22, 28, 30, 33, 35 and 41.
10. Alexander et al. does not explicitly teach (claims 3, 8 and 31) that said two or more persons perform a product purchasing transaction. However, the teaching is inherent or obvious

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because the vast bulk of visitors to a sports club or bar perform a product purchasing transaction. The reference does teach obtaining data on the product/service preferences of the two or more persons, and those products would inherently include or relate to common products being purchased at the sports club or bar location.

Allowable Subject Matter

11. Claims 4, 6, 8-12, 19, 21, 23-27, 32, 34 and 36-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
12. The following is an examiner's statement of reasons for the indication of allowable subject matter for all the claims except 6, 21 and 34 (claims 4, 19 and 32 and their dependents):
The closest prior art, Alexander et al., does not teach or suggest collecting data on the purchase history of the two or more persons. The reference teaches a television program guide (EPG) with substantial capability for real-time targeting of ads to one or more viewers based on analysis of their use of the EPG, viewing preferences, and other data inputs. Catalina Marketing teaches a purchase history database of 165 million persons, and Experian teaches a purchase history database of 98 million mail-order buyers. However, there is nothing in Alexander et al. or other prior art to suggest an advantage to providing the EPG with real-time access to purchase history data from these or any other sources. In particular, there is no reasonable expectation that paying for access to these proprietary databases would improve ad targeting enough to justify the cost.
13. For claims 6, 21 and 34: the closest prior art, Alexander et al., does not teach or suggest obtaining biometric data on said two or more persons. Scarampi teaches an eye movement monitor of television viewers to "accurately monitor the actual viewing habits and activities of individuals". However, the Alexander et al. reference also has this as its objective. The prior art does not teach or suggest any advantage for adding the teaching of Scarampi to that of Alexander et al. Frey et al. teaches a person-recognition system used in conjunction with purchase data to evaluate the effectiveness of ads and promotions. Neither Frey et al. nor any other prior art suggests obtaining biometric data on said two or more persons for, and contemporaneously with, selecting an optimum ad to be shown to said two or more persons.

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14. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

15. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Hunt et al. and Kinjo, which are not prior art, teach some features of the instant invention.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
17. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application is assigned are 703-746-7239 for regular official communications and 703-746-7238 for After Final official communications. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-305-3900.
18. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Examiner
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16 September 2002